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REMARKS

In the Office Action mailed October 5, 2003, the Examiner, in a third attempt, attempted to support the restriction of claims 10-32 solely through self-supporting statements. In an Election with Traverse mailed April 21, 2003, Applicant elected claims 1-9 of Group I. Notwithstanding this election, the Examiner simply provided a restated Restriction Requirement and did not substantially respond to applicant's traversal remarks.

The Examiner provided an original and now restated four-way restriction of claims 1-32. The Examiner identified inventions of Groups III and IV and Groups I and II as being related as product and process of use. The Examiner concluded that in the instant case the process can be practiced with another materially different product such as a product capable of reconstructing an image based on at least one R-R interval or a combination of first and second sets of partial MR image data. Interestingly, the language the Examiner used to identify the "materially different product" is language taken verbatim from the product claims 10-18 and 19-24. As such, it is clear that the Examiner fails to appreciate the burden that is imposed under MPEP §806.05(h) with respect to the burden of providing a viable alternative use.

Applying the analysis given by the Examiner, claims 1-9 and 25-32 are drawn to methods of "use" and, in contrast, claims 10-18 and 19-24 are drawn to "products." However, the examples that the Examiner has provided of materially different products for carrying out the uses of claims 1-9 and 25-32 are the products called for in claims 10-18 and 19-24. As such, it is clear that the Examiner is unclear as to what is required to support a requirement for restriction.

In other words, the Examiner concluded that the inventions of Groups III and IV are distinct from the inventions of Groups I and II. The support relied upon by the Examiner in concluding that the inventions are distinct is, simply, that the inventions are distinct. That is, the Examiner has applied circular reasoning to substantiate the conclusion that the inventions are distinct by relying upon the self-serving assertion that the inventions are distinct. However, it is simply not sufficient for the Examiner to state that the inventions are distinct. As set forth in MPEP §806.05(h), the Examiner must provide an example of a materially different product. On two separate occasions, the Examiner has failed to provide the requisite example.

The Examiner stated that Groups III and IV and Groups I and II are distinct because "(1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process using that product (MPEP § 806.05(h))." However, this is simply not the case. The Examiner identified the "product" as Groups III and IV, claims 10-18 and 19-24. Claim 10, in part, calls for a computer

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program to "receive a time-period signal indicative of an R-R interval representing a cardiac cycle of a patient." Claim 10 continues by claiming the acquisition of a first and second set of partial MR image data over a first and second acquisition period equal to the R-R interval. Also, claim 19, in part, calls for a computer programmed to "acquire a time period of an R-R interval of the heart rate" and "acquire MR data for a time comparable to the time period stored." Similarly, claim 1, in part, calls for "recording...future R-R intervals" and "acquiring n sets of MR data, a first MR data acquisition commencing at any point in an R-R interval." Additionally, claim 25, in part, calls for "recording a time period of R-R interval" and "acquiring non-gated MR data using the time period recorded to estimate R-R intervals." Therefore, the claims share numerous common elements and, as will be shown, are not materially different. That is, although claims are not identical, it is simply not possible for this process, as claimed, to be practiced with a materially different product and the Examiner's own example proves such.

The Examiner failed to identify that "the product as claimed can be used in a materially different process of using that product." MPEP §806.05(h) states that the burden is on the Examiner to provide an example, but the example need not be documented. In this case, the Examiner has not provided a feasible example but instead stated in generality that "the process can be practiced with another materially different product such as a product with a reconstructed image based on at least one R-R interval or on a combination of first and second sets of partial MR data." This statement is not a feasible example of how "the product as claimed can be used in a materially different process of using that product." MPEP §806.05(h).

The Examiner's statement is simply not an example. That is, summarily stating that "the process can be practiced with another materially different product such as a product with a reconstructed image based on at least one R-R interval or on a combination of first and second sets of partial MR data" is not example of an alternative product but an alternative process. Rather than give an example of an alternative product with which the process can be used, as required by MPEP §806.05(h), the Examiner has given an alternative process, i.e. to "reconstruct[] [an] image based on at least one R-R interval or on a combination of first and second sets of partial MR data" as the example. Therefore, the Examiner has failed to meet the burden required by MPEP §806.05(h) and the restriction must be removed.

Furthermore, "[i]f the Applicant either proves or provides a convincing argument that the alternative use suggested by the Examiner cannot be accomplished, the burden is on the Examiner to support a viable alternative use or withdraw the requirement." MPEP §806.05(h). Accordingly, since the alternative suggested by the Examiner does not meet the requirements as an example but instead actually illuminates that the process cannot be practiced with a materially

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different product, Applicant respectfully requests rejoinder of Groups III and IV and Groups I and II.

The Examiner next asserted that the “[i]nventions of Group IV and Group III are related as combination and subcombination.” Applicant is unclear as to the reasoning of the Examiner’s explanation. It is unclear what the Examiner means when the Examiner states that the “subcombination has separate utility such as a computer program.” Claim 10 (Group III) actually calls for a computer program as does claim 19 (Group IV). As such, these groups are not distinct. Furthermore, the Examiner has not shown how “[t]he subcombination has separate utility such as a computer program.” Specifically, claim 10 calls for a computer program for use with an MRI scanner and the body of the claim is replete with references to “MR image”. The Examiner cites MPEP §806.05(c), yet did not follow the guidance of this section. Section 806.05(c) states that “[i]n order to establish that combination and subcombination inventions are distinct, two-way distinctiveness must be demonstrated.” Additionally, to support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classifications, status, or field of search. See MPEP §808.02.

The Examiner has not demonstrated that (1) two-way distinctness is present between the combination and subcombination, and (2) that there is a reason for insisting on restriction, such a separate classification, status, or field of search. In fact, the Examiner classified Groups I, II and IV in Class 600 and classified Group III in class 700. While the Applicant does not disagree that the Examiner should perform a thorough search and review all relevant subclasses, Applicant questions the appropriateness of class 700 identified by the Examiner for Group III. That is, the identified class 700 is designated for “generic control systems or specific applications.” The Examiner has further decided that Group III is for “specific applications.” That is, the Examiner has classified the group in subclass 90, which is for specific applications. However, subclass 90 clearly states that “[f]or classification herein, there must be significant claim recitation of the data processing system or calculating computer and only nominal claim recitation of the external art environment.” However, claim 10 makes no reference to a data processing system or calculating computer in the body of the claim. Rather, only the preamble refers to a computer having a computer program. Furthermore, the preamble and body of the claim extend well beyond “nominal claim recitation of the external art environment.” Specifically, the preamble clearly calls for “[a] computer program for use with an MRI scanner.” Additionally, the body repeatedly calls for acquisition and then reconstruction of “MR image data.” Accordingly, claim 10 clearly recites the external art environment within which the computer and computer program reside.

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Additionally, the Examiner has classified Groups I, II and IV in Class 600. However, claim 19 (Group IV) specifically calls for "a computer programmed to..." As in claim 10 (Group III), claim 19 (Group IV) clearly calls for the external art environment. Therefore, Applicant does not see any relevant distinction between the claims 10 and 19 to justify such drastically different classifications.

Further, Section II of Section 806.05(c) states that "[i]f there is no evidence that combination AB_{sp} is patentable without the details of B_{sp}, restriction should not be required. In this case, referring to claim 10, if A is the MRI scanner with the associated hardware, and B_{sp} is the computer programmed to perform certain acts, then it is quite clear that claim 10 is not patentable without the details of B_{sp}. As set forth in Section II, in this situation, "the inventions are not distinct and a requirement for restriction must not be made, even though the subcombination [may have] separate utility."

Also, Applicant notes that because the claims have different preambles does not in itself justify restriction. The elements of the claims also govern the appropriateness of a requirement for restriction. A review of the elements clearly dictates rejoinder of all pending claims. Accordingly, the Examiner's restriction of Groups IV and III as combination and subcombination is unsupported and inappropriate. Therefore, Applicant respectfully requests rejoinder of Groups IV and III.

The Examiner next stated that "[i]nventions Group I and Group II are unrelated." The Examiner supports this assertion with the sole statement that "Group I does not contain the step of increasing cardiac stress." Therefore, the Examiner appears to believe that because one independent claim contains an element not called for in a second independent claim, the inventions are unrelated. However, MPEP §808.01 is clear that inventions are independent "where they are not connected in design, operation, or effect under the disclosure of the particular application under consideration." Therefore, the Examiner has applied an incorrect standard. That is, groups are unrelated if not connected in design, operation, or effect -- not if they contain different steps, or one different step.

Claim 1, while "not contain[ing] the step of increasing cardiac stress," in part, calls for "monitoring heart rate of a subject just prior to image acquisition to acquire a time period of an R-R interval; recording the time period from the heart rate monitoring to prospectively estimate future R-R intervals; and acquiring n sets of MR data, a first MR data acquisition commencing at any point in an R-R interval and extending for the time period recorded." Similarly, claim 25, in part, calls for "acquir[ing] a time period of an R-R interval of the heart rate; stor[ing] the time period of the R-R interval;...and reconstruct[ing] an MR image with the MR data acquired over

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at least one R-R interval as estimated by the time period stored." Therefore, Groups I and II are connected in design, operation, and effect because they both call for a method to acquire MR data using R-R intervals.

Furthermore, applying the Examiner's logic from the instant restriction, separate independent claims are unrelated unless the claims have identical elements and limitations. Under the Examiner's logic, separate independent claims are impermissible within a single application. However, this is not the standard under MPEP §806.04. MPEP §806.04 states:

If it can be shown that the two or more inventions are in fact independent, applicant should be required to restrict the claims presented to but one of such independent inventions. For example:

(A) Two different combinations, not disclosed as capable of use together, having different modes of operation, different functions or different effects are independent. An article of apparel such as a shoe, and a locomotive bearing would be an example. A process of painting a house and a process of boring a well would be a second example.

(B) Where the two inventions are process and apparatus, and the apparatus cannot be used to practice the process or any part thereof, they are independent. A specific process of molding is independent from a molding apparatus which cannot be used to practice the specific process.

(C) Where species under a genus are independent, for example, a genus of paper clips having species differing in the manner in which a section of the wire is formed in order to achieve a greater increase in its holding power.

Therefore, the MPEP and its associated guidance require a different conclusion than reached by the Examiner. Simply, the conclusion that two or more inventions are in fact independent requires a strict factual inquiry that the Examiner has neglected and the claims do not support. Accordingly, Applicant respectfully requests rejoinder Groups I and II.

For all the above reasons, restriction is not proper in this case, and Applicant respectfully requests withdrawal of the Restriction Requirement and rejoinder of claims 1-32.

Applicant has previously filed, on August 15, 2003, a Petition for Supervisory Review and the associated fee. In that Petition, applicant sought, in part, review of the restriction imposed in the Office Action mailed July 15, 2003. The Office mailed to the applicant on September 29, 2003 a Letter rescinding the Office Action mailed July 15, 2003. On the very same day the Office mailed Applicant A Decision On Petition of the above referenced Petition For Supervisory Review indicating that the Petition is moot as the action for which applicant sought review has been rescinded. As Applicant has already paid a petition fee only to have the

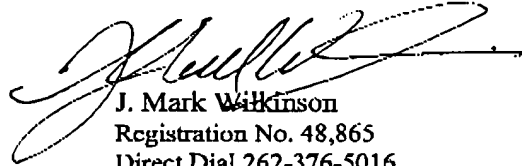
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Office rescind the action and reiterate the same action in a subsequent action, Applicant does not believe any additional fee is necessary or required.

Any questions regarding this matter can be directed to the undersigned.

Respectfully submitted,



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